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09/823,926	03/30/2001	Giovanni Campardo	856063.689	7548

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EXAMINER

LAMARRE, GUY J

ART UNIT	PAPER NUMBER
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2133

DATE MAILED: 03/26/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/823,926

Applicant(s)

CAMPARDO ET AL.

Examiner

Guy J. Lamarre, P.E.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 9 Jan. 2004 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### **Response to Amendment**

1. This office action is in response to Applicants' amendment of 9 Jan. 2004. The petition for 1-month extension of time, concurrently filed, is granted.

1.1 **Claims 1-6, 10, 15** are amended; **Claims 16-18** are added **Claims 1-18** remain pending.

1.2 The rejections of record are withdrawn in response to Applicants' amendment of 9 Jan. 2004.

1.3 The objections of record are withdrawn in response to Applicants' amendment of 9 Jan. 2004.

### **Response to Arguments**

2. Applicants' arguments of 9 Jan. 2004 have been fully considered and are deemed persuasive.

### **Claim Rejections - 35 USC § 112 SECOND PARAGRAPH**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.0 **Claim 2** stands rejected under 35 USC § 112 SECOND PARAGRAPH for failing to particularly point out and distinctly define the subject matter which the applicant regards as his invention.

3.1 **As per Claim 2:**

It is unclear to the Examiner what is loaded using the External matrix.

### **Claim Objections**

4. **Claims 1-3, 6, 10** are objected to under 37 CFR 1.75 because 'Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line

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indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP 608.01(i)-(p).'

**Claims 1-3** are objected to because of the typo: 'matriz' and 'testing step:' when no step was defined. Appropriate correction is required.

#### **Claim Rejections - 35 USC ' 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.0 This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5.1 **Claims 1-5, 6-8 and 16-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mullarkey et al.** (US 5,732,033) in view of **Bond et al.** (US 4,450,559) in further view of **Russ et al.** 'Non-intrusive built-in self-test for FPGA and MCM applications,' IEEE; page(s): 480 – 485; 8-10 Aug. 1995.

Referring to **claims 1-5, 6-8 and 16-18**, **Mullarkey** teaches to use "an integrated memory device 10" (see Fig.1) comprising "a memory array 12", including "a plurality of memory cells 22", "control circuit 16", and "a test mode 20" provided for operating the memory device 10 in a test regime.

**Mullarkey** does not explicitly point out to use two memories, but **Bond et al.** teaches to comprise two memories- "main memory system 11" and "secondary memory unit 13" (see Fig.1) coupled with the "electronic control system (ECC) 10". **Bond et al.** does not explicitly point out that both of memories are internal, inherently teaching for any combinations (internal/external) of two memories. Also, it is well known that mostly integrated circuits do not contain the test

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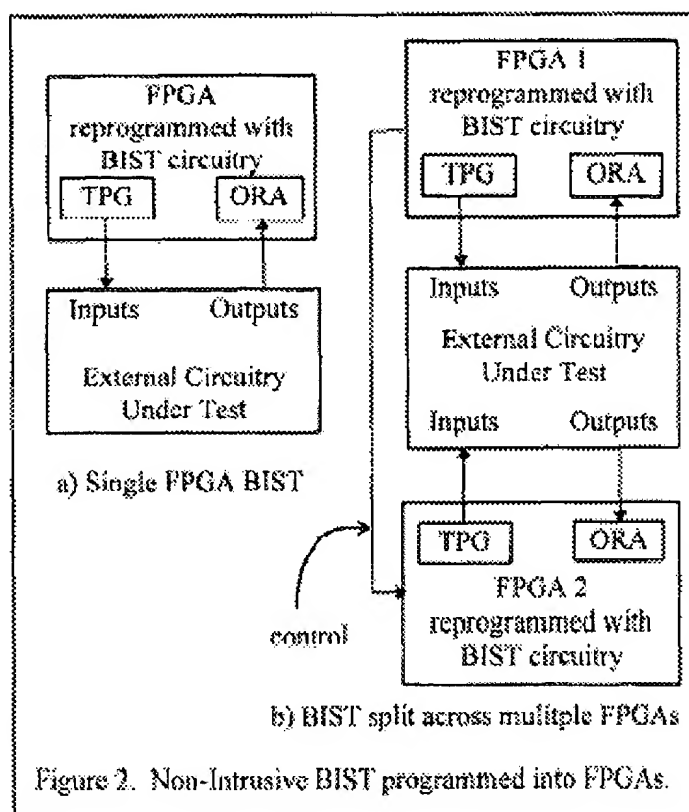
operation memory (accept some specific integrated circuit particularly intended, e.g. for memory testing).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify **Mullarkey** with the teaching of **Bond** by simply using one memory as internal and second memory as external, because one of ordinary skill in the art would simply use an external memory for the test of the memory into integrated circuit to provide minimization of the integrated circuit (IC) dimensions, universality of application, and convenience for the test equipment.

While **Mullarkey** and **Bond et al.** substantially disclose the procedure for the claimed means, **Mullarkey** and **Bond et al.** fail to specifically mention that the external test operation means for testing the DUT.

However such approach of is well known, especially since off-line testing is often required.. For example, **Russ et al.**, in an analogous art, discloses BIST algorithms for FPGA and MCM applications, wherein such techniques are described. {See **Russ et al.**, Id., Abstract and Introduction, and Fig. 2.}

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the procedure of **Mullarkey** and **Bond et al.** by including therein external test operation means as taught by **Russ et al.**, because such modification would provide the procedure disclosed in **Mullarkey** and **Bond et al.** with a technique whereby it is possible to design a BIST system *"the normal system function can be reprogrammed during off-line testing to provide BIST capabilities for testing external devices... connected to the FPGA such that no area or performance penalties are incurred by the system function."* {See **Russ et al.**, Id., page 480 penultimate para., at col. 2. }



**Claims 7, 8** depend from respective claim 6, hence inherit the rejection in claim 6. Also, according to claim 7, Mullarkey teaches to use the "input/output circuits 18" (column 3, lines 41, 42) and contacts (e.g. "contact 99" /see column 8, line 32, and Fig.6/) for connections. Additionally, it is well known that the integrated circuits and/or electrical/electronic devices are provided with data pins and/or address pins for connection of the integrated circuit (IC) and/or electrical/electronic devices, and explicitly pointed out and disclosed, for instance, in device by Mullarkey.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify or simply, to use Mullarkey's input/output circuit and/or contacts for connection, because one of ordinary skill in the art with the teaching of Mullarkey by including use the contacts (pins) for electrical connection of the external electronic components, because (IC) are obviously needed to be electrically connected to the PCB (Printed Circuit Board) and/or test equipment, that can be provided the use of pins and/or contacts.

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**5.2** Claim 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullarkey et al. (US 5,732,033) in view of **Russ et al.** 'Non-intrusive built-in self-test for FPGA and MCM applications,' IEEE; page(s): 480 – 485; 8-10 Aug. 1995 in further view of Kumakura et al. (US 5,566,386).

Applicant claims the nonvolatile type of the external memory unit 7. Mullarkey does not explicitly teach and point out to nonvolatile memory, inherently teaching to use any kind of memory, but Kumakura et al. teaches to use "a nonvolatile semiconductor memory and a test method for the same" (e.g. , see a title and cross specification) and Applicant admits that such is well known in page 1 line 6.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Mullarkey and **Russ et al.** with the teaching of Kumakura by using inherently any kind of memory for testing, including the nonvolatile memory, because the memory test equipment, providing the test of the memory and control logic operability, mostly (by their purpose and application) is developed as an universal device for testing of the different kinds of integrated memory circuits, logically including the nonvolatile memory.

Referring to claim 9, the device by Mullarkey et al. Includes the "memory array 12", "control means 16" and "test mode 20" (column 3, lines 40-43), Mullarkey does not explicitly teach and point out to the external test control, but teaches to use a control circuit 16, a test mode 20 and appropriate memory array (inherently internal) 12, including a plurality of "memory cells 22" (column 3, line 49), provided for operating the memory device 10 in a test regime.

Kumakura et al. teaches the test control means including "operation logic circuit 3", "command register 2" (column 6, lines 61, 62), "test cell 19", "switching circuit 7" (column 6, line 64), "timing generating circuit 10", "erasure source control circuit 18" (column 7, line 8), and other analogous means presented in the applicant's claims. Also, it is well known that some

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integrated circuits do not contain the test control device (except for specific integrated circuit particularly intended, e.g. for memory testing devices).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Mullarkey with the teaching of Kumakura by using the test control device as a testing equipment, because mostly the test control devices are external apparatus, and it is well known and obvious, that test control devices can include the circuit for simulating the internal memory array in order to provide maximally efficient test of the internal memory operability. Simulation allows for system operation observation prior to commitment to hardware so as to save costs.

Claims 10, 11 depend from respective claim 9 hence inherit the rejection in claim 9. Also, claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mullarkey et al. (US 5,732,033) in further view of **Russ et al.** 'Non-intrusive built-in self-test for FPGA and MCM applications,' IEEE; page(s): 480 – 485; 8-10 Aug. 1995.

Mullarkey teaches to use the input/output circuits 18 (column 3, lines 40, 41) and contacts (e.g. contact 99 /see column 8, line 32 and Fig.6/) for connections. Additionally, it is well known that the integrated circuits and/or electrical/electronic devices can be provided with the contacts or connector for detachable connection, for instance, by a socket. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify or simply to use Mullarkey's input/output circuit and/or contacts/connectors for connection, because one of ordinary skill in the art with the teaching of Mullarkey by including use the detachable connection (e.g. connector) for electrical connection of the external electronic components (e.g. semiconductor substrate) to, for example, PCB and/or test control unit in order to provide sufficient universality of the test equipment. **Russ et al.** teaches to use the input/output circuits in, e.g., Fig. 2.



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5.3 Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mullarkey et al. (US 5,732,033) in view of **Russ et al.** 'Non-intrusive built-in self-test for FPGA and MCM applications,' IEEE; page(s): 480 – 485; 8-10 Aug. 1995 in further view of Kumakura et al. (US 5,566,386).

Mullarkey et al. teaches, that the memory device comprises the circuit for simulating the memory array and the circuit for simulating the control logic circuit integrated into test device ("invention provides an arrangement for rapidly equilibrating the paired digit lines of the memory array of a semiconductor memory device, such as a dynamic random access memory device", e.g., see column 9, lines 20-24), during testing of the memory device. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify or simply to use Mullarkey's integrated means, because one of ordinary skill in the art with the teaching of Mullarkey by including circuit for simulating the internal memory array and the circuit for simulating the control logic circuit into test device, that is mostly the regular procedure for internal memory array test providing the efficient memory test result.

Referring claims 12, 13, Mullarkey et al. teaches, that the memory device comprises the circuit for simulating the memory array. Mullarkey et al. does not limit and/or explicitly point out the memory array location, inherently teaching to use any and all possible locations of the memory array.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify or simply to use Mullarkey's memory array, for example, as an external, because one of ordinary skill in the art with the teaching of Mullarkey by including circuit for simulating the internal memory array into test device, that is mostly the regular procedure for internal memory array test providing the efficient memory test result by external memory array, located into the test equipment.

5.4 Claims 14, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullarkey et al. (US 5,732,033) in view of **Russ et al.** 'Non-intrusive built-in self-test for FPGA and

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MCM applications; IEEE; page(s): 480 – 485; 8-10 Aug. 1995 in further view of Kumakura et al. (US 5,566,386).

According to claim 14, Kumakura et al. teaches to operate (simulate) the test control means including "operation logic circuit 3", "command register 2" (column 6, lines 61, 62), "test cell 19", "switching circuit 7" (column 6, line 64), "timing generating circuit 9", "erasure source control circuit 18" (column 7, line 8), and other analogous means presented in the applicant's claims.

Kumakura does not explicitly teach and point out to the external location of any or some means, inherently teaching to use a control circuit 16, a test mode 20 and appropriate memory array (inherently internal) 12, including a plurality of memory cells 22, for operating the memory device 10 in a test regime.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kumakura with the teaching of by using the external location of any/some means for memory test, because it is obvious and well known, that the procedure for most tests and particularly for memory test control apparatus includes steps of simulating the circuits, performing the test, and observing interactions and results, considering the purpose of the testing equipment.

Referring to claim 15, Kumakura et al. teaches to operate (simulate) the test control means including "operation logic circuit 3", "command register 2", "test cell 19", "switching circuit 7", "timing generating circuit 9", "erasure source control circuit 18", and other analogous means presented in the applicant's claims. Kumakura does not explicitly teach and point out to the external location of any or some means, inherently teaching to use a "control circuit 16", "a test mode 20" and appropriate "memory array (inherently internal) 12", including a plurality of "memory cells 22", for the memory device 10 in a test regime.

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Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kumakura with the teaching of by using the external location of any/some means for memory test, because it is well known and follows from the IC technology ideology, that in order to increase degree of IC's integration and universality they do not include the test circuits (except some specific IC), and obviously such means for memory test have to be externally located into test apparatus

5.5 Claims 1-5 are similar to claims 6-15, and are rejected based on the same rationale thereof.

### Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Guy J. Lamarre, P.E., whose telephone number is (703) 305-0755. The examiner can normally be reached on Monday to Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert De Cady can be reached on (703) 305-9595. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Guy J. Lamarre, P.E.  
Patent Examiner  
3/22/04

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